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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,586	03/09/2004	Christina Prowell	4962	1112

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BASF CATALYSTS LLC  
101 WOOD AVENUE  
ISELIN, NJ 08830

EXAMINER

POULOS, SANDRA K

ART UNIT PAPER NUMBER

1714

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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# **Office Action Summary**

Application No.

10/796,586

Applicant(s)

PROWELL ET AL.

Examiner

Sandra K. Poulos

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1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## **Status**

- 1) ☒ Responsive to communication(s) filed on 09 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## **Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## **Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## **Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/8/04; 6/22/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Information Disclosure Statement*

1. The reference US 4,677,141 has been submitted twice; therefore examiner has not considered the duplicate citation.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 22 are indefinite because it is not clear whether amino-or vinyl-functionalized applies to both organosilane and organosiloxane, i.e. (1) amino-or vinyl-functionalized organosilane or (2) amino-or vinyl-functionalized organosiloxane, or (1) amino-or vinyl-functionalized organosilane or (2) organosiloxane.

Claim 18 is indefinite because the claim does not define "a" or "n" in the formulae.

Claim 18 appears to improperly recite a Markush group. Consequently, it is impossible to determine which elements of the group are required by the claim\*\*\*.

When materials recited in a claim are so related as to constitute a proper Markush group, they may be recited in the conventional manner, or alternatively. For example, if "wherein R is a material selected from the group consisting of A, B, C and D" is a proper

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limitation, then "wherein R is A, B, C or D" shall also be considered proper (emphasis added). See MPEP § 2173.05(h).

The remaining claims are rejected under 35 U.S.C. 112, second paragraph, as being dependent upon a rejected base claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 11, 16, 18-19, 21-23, 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Sekutowski (US 4,740,538).

Sekutowski discloses a nylon plastic composite containing a kaolin filler coated with an amino functional silane coupling agent that results in an improved impact strength (abstract). The amino silane is used in an amount of 0.1-5% (col 3, lines 3-5), and 1.4% in the samples (col 13). The silane used in the examples is aminopropyltriethoxysilane (A-1100)(col 13). Silica does not appear in the examples. Sample 14 contains A-1100 and silicone oil as treating agents for the filler (col 15).

Thus Sekutowski anticipates the cited claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-15, 18 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cornelius et al (US 4,677,141).

Cornelius discloses a method of improving the heat stability of silicone elastomers with pretreated white clay (abstract). The composition can be pigmented (abstract). Kaolin is particularly preferred because it is readily available in white form (col 4, lines 30-31). The clay in example 1 is calcined kaolin clay treated with approximately 1% of vinyl-tri(beta-methoxyethoxy)silane and has a particle size of 0.81 micrometers (col 7, lines 15-21). The amount of clay is from 1 to 150 parts by weight (col 2, lines 21-22). The silicone elastomer is heated to vulcanize (abstract), however the time and temperature necessary to cause vulcanization are dependent on the vulcanization agent, the method of heating, the method of forming the composition into a shape, and the thickness of the part (col 6, lines 26-30). Cornelius discloses that the temperature that is appropriate for a given set of conditions is well known in the silicone elastomer art (col 6, lines 30-32).

Cornelius does not disclose the amount of organosilane generally used to pretreat the kaolin clay, but gives one example where "approximately 1 percent" is used.

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It would have been obvious to one of ordinary skill in the art to that approximately 1% would include a variation of about  $\pm 0.2\%$  which would meet the claimed limitation of 1.1% or 1.2%.

It is noted that claims 13-14 are product-by-process claims and therefore “even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” See *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Although Cornelius does not disclose vulcanization at ambient temperature, it is examiner’s position that although it is not specifically recited, the silicone elastomer disclosed by Cornelius would nonetheless intrinsically meet the claimed requirements since it is vulcanized, or alternatively, it would have been obvious to vary the vulcanization temperature to include ambient temperature in addition to elevated temperatures because Cornelius discloses that the temperature that is appropriate for a given set of conditions is well known in the silicone elastomer art.

5. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sekutowski (US 4,740,538).

The discussion with respect to Sekutowski in paragraph 3 above is incorporated herein by reference.

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Sekutowski discloses the amount of aminoalkylsilane is 0.1-5% (col 3, lines 3-5), and 1.4% in the samples (col 13), but does not disclose about 1.24% of the aminosilane; however, it would have been obvious to one of ordinary skill in the art that "about 1.24%" would include a variation of about  $\pm 0.2\%$  which would overlap 1.4%, as disclosed by Sekutowski.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra K. Poulos whose telephone number is (571) 272-6428. The examiner can normally be reached on M-F 8:00-4:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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